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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,289	07/17/2003	Richard W. Ragan JR.	RSW920030060US1	2496
45541 7590 07/29/2008 HOFFMAN WARNICK LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207				
EXAMINER THERIAULT, STEVEN B				
ART UNIT		PAPER NUMBER		
2179				
MAIL DATE		DELIVERY MODE		
07/29/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/621,289

Applicant(s)

RAGAN ET AL.

Examiner

STEVEN B. THERIAULT

Art Unit

2179

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Weilun Lo/
Supervisory Patent Examiner, Art Unit 2179

/Steven B Theriault/
Patent Examiner
Art Unit: 2179

continuation of 13. Other: The following is a further discussion along with the statement made above relating to the affidavit presented after a final rejection filed 07/10/2008. The Affidavit filed on 7/10/2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Eruhimov et al. reference. Further, the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Eruhimov reference. Moreover, the evidence submitted is insufficient to establish diligence during the critical period (04/24/2003 - 07/17/2003).

The Examiner relied on the following to conclude that the 1.131 affidavit submitted on 7/10/2008 is insufficient. MPEP 715.07 establishes facts and evidence to be considered when evaluating a 1.131 document and MPEP 2138.04 - 2138.06 in conjunction with MPEP 715.07 show the procedure regarding conception and reduction to practice.

The Examiner constructed the following time pattern: Applicant shows an exhibit A that claims an inventor disclosure statement was filed on 08/19/2002. The reference used in the rejection has a 102 (e) date of 04/25/2003. The filing date of the application was 07/17/2003. The critical period of diligence is 04/24/2003 - 07/17/2003.

MPEP 715.07 states: "a conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws and confers no rights on an inventor and has no effect on the subsequently granted patent to another. **UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT**, such as actual reduction to practice or filing of the application for a patent." While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In this case, exhibit A is analyzed according to 2138.04 -2138.05, as not providing a sufficient disclosure under the "how to use" and "how to make" requirements of 35 USC 112, first paragraph and showing the requisite "means" and their interaction of the software as claimed. The Examiner contends that the exhibit does not recite "how to use" or "how to make" the claimed invention and lacks a written description requirement of 112 1st, because the application has not been defined in such a way as to reduce the invention to a practical form without the "exercise of the extensive experimentation". The evidence submitted does not include the system or description of the software and/or hardware to realize the claims as submitted in the affidavit. The exhibit appears to revolve around a general description or narrative of what the application does but provides no discussion as to implementation.

MPEP 2138.06 specifically states that "The work relied upon to show reasonable diligence must be directly related to the reduction of practice of the invention". Further, MPEP 2138.06 is clear that when an applicant makes a general allegation or broad statement, in terms of what the exhibits describe or that the invention has been reduced to practice, that if these statements are made without supporting evidence then the statements amount essentially to mere pleading, as there is no supported proof or showing of facts. In this case, Applicant's merely make a statement as to diligence and do not support the assertion with facts in the exhibit and provide no discussion as to how the diligence is directly related to the reduction of practice of the invention. It is not clear from the affidavit that reasonable diligence has been established, as there are no records, journals, statements or even a log to show when the applicant has executed acts to reduce the invention to practice during the period mentioned above. The exhibit also does not appear to provide evidence as to reasonable diligence performed during the critical period. The period of April 24, 2003, one day before the cited reference through July 17, 2003 (critical period) is not accounted for in the exhibit and appears to be directed to attorney diligence in preparing the application. MPEP 2138.06 outlines acceptable diligence has been found where six days to execute and file an application and further states "The court has distinguished that diligence was not found because the inventors have discontinued development or failed to complete the invention while pursuing financing or other commercial activity." In this case, no detailed accounting of what took place during the critical period has been provided.

It is also noted that the 37 CFR 1.131 affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference or activity were carried out in this country or in a NAFTA country or WTO member country. See 35 U.S.C. 104. The affidavit merely points out that the invention was disclosed in an inventor disclosure statement that was archived in the IBM corporate patent department and makes no mention as to where the activity was carried out.

In summary, the Examiner has maintained the previous rejection, based on the 102(e) rejection over Eruhimov because the exhibit does not contain evidence to prove conception, as the disclosure statement does not provide a sufficient disclosure as to "how to make and use" the invention in accordance with 112, 1st, and the affidavit does not contain evidence to support diligence during the critical period.

Claims 1-25 remain finally rejected (See final rejection mailed 05/29/2008).